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In re Application of: Scheller et al.

Serial No. 10/586,018

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For: SURGICAL INSTRUMENT
HANDLE WITH ADJUSTABLE
ACTUATOR POSITION

Examiner: Chen, Victoria W.

Group Art Unit: 3739

APPEAL BRIEF UNDER 37 CFR § 41.37

Applicants herein file their appeal of the Final Rejection of claims 1, 3-10, 12 and 13 made in the Patent Office Action having a notification date of August 14, 2009.

(1) Real Party In Interest

The real party in interest in this Appeal is Synergetics, Inc., 3845 Corporate Centre Drive, St. Charles, MO 63304, by way of an Assignment of the inventors' interests recorded on November 1, 2006, at Reel No. 018465, Frame No. 0823.

(2) Related Appeals and Interferences

There are no related appeals and/or interferences.

(3) Status of Claims

Claims 1-14 are pending in the application.

Claim 2 has been allowed.

Claims 11 and 14 have been objected to, and have also been indicated as reciting allowable subject matter.

Claims 1, 3-10, 12 and 13 have been given a Final Rejection.

The Final Rejection of claims 1, 3-10, 12 and 13 is being appealed herein.

(4) Status of Amendments

No amendments have been filed in the application following the Final Rejection of claims 1, 3-10, 12 and 13, made in the Office Action having a notification date of August 14, 2009.

(5) Summary of Claimed Subject Matter

The subject matter of the invention defined by independent claim 1 is a surgical instrument handle that comprises an elongate rod 14 having a center axis that defines mutually perpendicular axial and radial directions. The rod 14 has a length with axially opposite proximal 38 and distal 42 ends. The rod distal end 42 is adapted to be

attached to a surgical instrument head (specification page 2, lines 1-4, and page 3, lines 3-7).

A piston 16 is mounted on the rod 14 adjacent the rod distal end 42 and is adapted to have axially reciprocating movement toward and away from the rod distal end 42 (specification page 2, lines 1-4, and page 3, lines 11-12).

A forward grip member 82 is mounted on the rod 14 (specification page 5, lines 17-18) and is adapted to have axial movement between first and second positions of the forward grip member 82 relative to the rod 14 (specification page 5, lines 21-23, and page 7, lines 3-20). The forward grip member 82 has a plurality of resilient arms 102 that extend along the rod 14 (specification page 4, lines 9-11, and lines 19-24). The plurality of arms 102 have distal ends 92 that operatively engage with the piston 16 whereby manual movement of the arm distal ends 92 radially inwardly moves the piston 16 axially toward the rod distal end 42 (specification page 6, lines 11-18), and movement of the piston 16 axially away from the rod distal end 42 moves the arm distal ends 92 radially outwardly (specification page 6, line 19, to page 7, line 2). There is a first radial spacing between the arm distal ends 92 when the forward grip member 82 is in the first position relative to the rod 14, and there is a second radial spacing between the arm distal ends 92 when the forward grip member 82 is in the second position relative to the rod 14, the second radial spacing being larger than the first radial spacing (specification page 7, lines 3-20).

The subject matter of the invention defined by independent claim 3 is a surgical instrument handle that comprises an elongate rod 14 having a center axis that defines mutually perpendicular axial and radial directions. The rod 14 has a length with axially

opposite proximal 38 and distal 42 ends. The rod distal end 42 being adapted to be attached to a surgical instrument head (specification page 2, lines 1-4, and page 3, lines 3-7).

A piston 16 is mounted on the rod 14 adjacent the rod distal end 42. The piston 16 is adapted to have axially reciprocating movement toward and away from the rod distal end 42 (specification page 2, lines 1-4, and page 3, lines 11-12).

A forward grip member 82 is operatively connected with the rod 14 (specification page 5, lines 17-18) and is adapted to have axial movement between first and second positions of the forward grip member 82 relative to the rod 14 (specification page 5, lines 21-23, and page 7, lines 3-20). A plurality of resilient arms 102 are integrally connected with the forward grip member 82 and are operatively connected with the piston 16. Manual movement of the arms 102 radially inwardly moves the piston 16 axially toward the rod distal end 42 (specification page 6, lines 11-18), and movement of the piston 16 axially away from the rod distal end 42 moves the arms 102 radially outwardly (specification page 6, line 19, to page 7, line 2). There is a first radial spacing between the arms 102 when the forward grip member 82 is in the first position relative to the rod 14, and there is a second radial spacing between the arms 102 when the forward grip member 82 is in the second position relative to the rod 14, the second radial spacing being larger than the first radial spacing (specification page 7, lines 3-20).

The subject matter of the invention defined by independent claim 8 is a surgical instrument handle that comprises an elongate rod 14 having a center axis that defines mutually perpendicular axial and radial directions. The rod 14 has a length with axially opposite proximal 38 and distal 42 ends. The rod distal end 42 is adapted to be

attached to a surgical instrument head (specification page 2, lines 1-4, and page 3, lines 3-7).

A piston 16 is mounted on the rod 14 adjacent the rod distal end 42. The piston 16 is adapted to have axially reciprocating movement toward and away from the rod distal end 42 (specification page 2, lines 1-4, and page 3, lines 11-12).

A forward grip member 82 is operatively connected with the rod 14 (specification page 5, lines 17-18) and is adapted for axial movement between first and second positions of the forward grip member 82 relative to the rod 14 (specification page 5, lines 21-23, and page 7, lines 3-20). A plurality of resilient arms 102 are operatively connected with the forward grip member and are operatively connected with the piston 16. Manual movement of the arms 102 radially inwardly moves the piston 16 axially toward the rod distal end 42 (specification page 6, lines 11-18), and movement of the piston 16 axially away from the rod distal end 42 moves the arms 102 radially outwardly (specification page 6, line 19, to page 7, line 2). There is a first radial spacing between the arms 102 when the forward grip member 82 is in the first position relative to the rod 14, and there is a second radial spacing between the arms 102 when the forward grip member 82 is in the second position relative to the rod 14, the second radial spacing being larger than the first radial spacing (specification page 7, lines 3-20).

A ring 18 is mounted on the rod 14 where the ring 18 is adapted to have reciprocating movement of the ring 18 toward the rod proximal end 38 and toward the rod distal end 42. The ring 18 engages with the piston 16 (specification page 3, lines 17-20).

(6) Grounds of rejection to be reviewed on Appeal

The grounds of rejection to be reviewed on appeal is the Final Rejection of claims 1, 3-10, 12 and 13 under 35 U.S.C. § 102(b) as being anticipated by the disclosure of the U.S. Patent of Richards No. 5,634,918.

(7) Argument

Claims 1, 3-10, 12 and 13 were rejected under 35 U.S.C. § 102(b) as being anticipated by the disclosure of the U.S. Patent of Richards No. 5,634,918. Of these rejected claims, claims 1, 3 and 8 are independent claims. Claims 4-7, 12 and 13 depend from claim 3, and claim 9 and 10 depend from claim 8.

It is respectfully submitted that the independent claims 1, 3 and 8 recite elements of the invention that are not identically shown by the Richards reference. The rejection is based on factual errors made in what the Richards reference actually discloses, and on legal errors in appropriately construing the claim language. Therefore, the Richards reference does not anticipate the subject matter of these claims under the patent law.

For a prior-art reference to anticipate, every element of the claimed invention must be identically shown in a single reference.

In Re Bond, 910 F.2d 831, 15 USPQ 2d 1566, 1567 (Fed. Cir. 1990).

[A]ny degree of physical difference, however slight, invalidates claims of anticipation.

Ultradent Products, Inc. v. Life-Like Cosmetics, Inc., 924 F. Supp. 1101, 39 USPQ 2d 1969, 1980 (D. Utah 1996), aff'd in part, rev'd in part on other grounds, 127 F.3d 1065, 44 USPQ 2d 1336 (Fed. Cir. 1997).

Anticipation requires identity of invention. The claimed invention, as described in appropriately construed claims, must be the same as that of the reference in order to anticipate.

Glaverbel Societe Anonyme v. Northlake Marketing & Supply, Inc., 45 F.3d 1550, 33 USPQ 2d 1496, 1498, 1995-1 Trade Cas. (CCH) P 70891 (Fed. Cir. 1995).

Claim 1 recites a surgical instrument having an elongate rod 14 and a forward grip member 82 mounted on the rod. The claim further recites “the forward grip member having a plurality of resilient arms that extend along the rod.” Claim 3 recites a surgical instrument having an elongate rod 14 and a forward grip member 82 operatively connected with the rod. Claim 3 further recites “a plurality of resilient arms integrally connected with the forward grip member.” Claim 8 also recites a surgical instrument having an elongate rod 14 and a forward grip member 82 operatively connected with the rod.” The claim further recites “a plurality of resilient arms operatively connected with the forward grip member.”

Each of the independent claims discussed above recites a forward grip member 82 where the forward grip member has a plurality of resilient arms 102. As used in the claims and according to common understanding, “a” means one when used before a noun and when used to express a quantity. The language of the claim is describing one forward grip member.

The Richards reference does not disclose or suggest one forward grip member having a plurality of arms. In the anticipation rejection of the independent claims 1, 3, and 8, the rejection refers to Figure 4 of the Richards reference and interprets the rod 14 of Figure 4 as the rod recited in claims 1, 3, and 8. The rejection further interprets the six triggers 20 shown in Figure 4 as “a forward grip member” 82 as recited in claims 1, 3, and 8. The “Response to Arguments” explains that the examiner is interpreting the six separate triggers 20 of Richards as “a forward grip member.”

It is respectfully submitted that interpreting six separate members as a member is not appropriately construing the language of claims 1, 3 and 8.

In viewing Figures 3 and 3A of the Richards reference, it can be seen that each trigger 20 has only one tie arm 20T and only one hook 20H at the distal end of the tie arm (see column 3, lines 25-31 of the Richards reference). What the Richards reference actually does disclose is a plurality of triggers 20, with each trigger having only one tie arm 20T and only one hook 20H at the distal end of the tie arm.

The ordinary meaning of the claim language is one forward grip member where the one forward grip member has a plurality of arms. This element of the claimed invention is not identically shown by the six separate triggers of the Richards reference. In view of this error made in appropriately construing the language of claims 1, 3 and 8, it is respectfully submitted that the rejection should be reversed and the claims allowed.

Appropriately construing the language of the independent claims 1, 3, and 8, as is required by the above-cited case law, the Richards reference does not identically show a forward grip member having a plurality of resilient arms, and therefore does not identically show every element of the claimed invention recited in the independent claims 1, 3, and 8, as required for a proper anticipation rejection under the above-cited case law. The Richards reference therefore does not anticipate claims 1, 3-10, 12, and 13 as contended in the rejection of claims 1, 3-10, 12, and 13.

Furthermore, independent claim 1 recites the elongate rod 14 having a distal end 42 that is adapted to be attached to a surgical instrument head, the piston 16 being mounted on the rod adjacent the rod distal end 42, and the plurality of arms having distal ends 92 that operatively engage with the piston 16 whereby manual movement of the arm distal ends 92 radially inwardly moves the piston 16 axially toward the rod distal

end 42 and movement of the piston 16 axially away from the rod distal end 42 moves the arm distal ends 92 radially outwardly.

Independent claim 3 also recites the elongate rod 14 having a distal end 42 adapted to be attached to a surgical instrument head, a piston 16 mounted on the rod 14 adjacent the rod distal end 42, and a plurality of resilient arms 102 operatively connected with the piston 16 whereby manual movement of the arms 102 radially inwardly moves the piston 16 axially toward the rod distal end 42, and movement of the piston 16 axially away from the rod distal end 42 moves the arms 102 radially outwardly.

Independent claim 8 also recites an elongate rod 14 having a distal end 42 adapted to be attached to a surgical instrument head, a piston 16 mounted on the rod 14 adjacent the rod distal end 42, and a plurality of resilient arms 102 operatively connected with the piston 16 whereby manual movement of the arms 102 radially inwardly moves the piston 16 axially toward the rod distal end 42, and movement of the piston 16 axially away from the rod distal end 42 moves the arms radially outwardly.

In the anticipation rejection of claims 1, 3, and 8, the rejection refers to Figure 4 of the Richards reference and interprets the rod 14 as the rod of claim 1. It therefore appears that the forward end 18 of the rod 14 in the Richards reference is interpreted as the claimed rod distal end 42 because the forward end 18 is the end that is adapted for attachment to a surgical instrument head as recited in the rejected claims. The rejection of claims 1, 3, and 8 also interprets the tie arms 20T as the claimed plurality of resilient arms and contends that the plurality of resilient arms 20T, 20H "operatively engage the piston [via elements 22 and 32], whereby manual movement of the arm distal ends radially inwardly [Fig. 4], moves the piston axially toward the rod

distal end [Fig. 4], and movement of the piston axially away from the rod distal end moves the arm distal ends radially outwardly [Fig. 3]," (quoting from the rejection of independent claim 3). However, this interpretation of what is shown in Fig. 3 and Fig. 4 of the Richards reference is incorrect

The interpretation relies on the entirety of both the length of the trigger tie arm 20T and the tie arm hook 20H as the claimed "arms having distal ends that operatively engage with the piston," and the plurality of arms "operatively connected with the piston." However, only the tie arm hooks 20H are described by Richards as being at the tie arm distal end (column 3, lines 28-30) and only the tie arm hooks 20H engage in the grooved region 24 of the trigger retainer 22. The tie arm 20T is described as being curved to circulate around the rod (column 3, lines 28-30) and is not described as engaging with anything. Only the tie arm hooks 20H operatively engage the piston and the interpretation that the tie arms 20T also operatively engage the piston is based on an incorrect interpretation of the Richards reference.

Referring to Figures 3 and 4 of the Richards reference, Figure 3 shows the piston 34 moved away from the rod distal end 18, and Figure 4 shows the piston 34 moved toward the rod distal end 18. In Figure 3, the tie arm hooks 20H are radially closer to the center axis 26 of the rod than are the tie arm hooks 20H shown in Figure 4. Thus, when the tie arm hooks 20H of the Richards reference are moved toward the center axis 26 of the rod or radially inwardly, the piston 34 is moved away from the rod distal end as shown in Figure 3, and not toward the rod distal end as claimed. In addition, when the tie arm hooks 20H in the Richards reference are moved away from the rod

center axis 26 or radially outwardly as shown in Figure 4, the piston 34 is moved toward the rod distal end 18, and not away from the rod distal end as claimed.

The Richards reference therefore does not identically show every element of the invention recited in independent claims 1, 3, and 8 as is required for a proper anticipation rejection under the above-cited case law. Interpreting the language of the independent claims 1, 3, and 8 reasonably, the Richards reference does not identically show every element of the claimed invention. The Richards reference therefore does not anticipate claims 1, 3, and 8, and claims 1-14 currently pending in the application are allowable over the prior art.

(8) Claims Appendix

1) A surgical instrument handle comprising:

an elongate rod having a center axis that defines mutually perpendicular axial and radial directions, the rod having a length with axially opposite proximal and distal ends; the rod distal end being adapted to be attached to a surgical instrument head;

a piston mounted on the rod adjacent the rod distal end wherein the piston is adapted to have axially reciprocating movement toward and away from the rod distal end;

a forward grip member mounted on the rod wherein the forward grip member is adapted to have axial movement between first and second positions of the forward grip member relative to the rod, the forward grip member having a plurality of resilient arms that extend along the rod, the plurality of arms having distal ends that operatively engage with the piston whereby manual movement of the arm distal ends radially inwardly moves the piston axially toward the rod distal end and movement of the piston axially away from the rod distal end moves the arm distal ends radially outwardly, there being a first radial spacing between the arm distal ends when the forward grip member is in the first position relative to the rod, and there being a second radial spacing between the arm distal ends when the forward grip member is in the second position relative to the rod, the second radial spacing being larger than the first radial spacing.

- 3) A surgical instrument handle comprising:
 - an elongate rod having a center axis that defines mutually perpendicular axial and radial directions, the rod having a length with axially opposite proximal and distal ends; the rod distal end being adapted to be attached to a surgical instrument head;
 - a piston mounted on the rod adjacent the rod distal end wherein the piston is adapted to have axially reciprocating movement of the piston toward and away from the rod distal end;
 - a forward grip member operatively connected with the rod wherein the forward grip member is adapted to have axial movement between first and second positions of the forward grip member relative to the rod;
 - a plurality of resilient arms integrally connected with the forward grip member and operatively connected with the piston whereby manual movement of the arms radially inwardly moves the piston axially toward the rod distal end, and movement of the piston axially away from the rod distal end moves the arms radially outwardly, there being a first radial spacing between the arms when the forward grip member is in the first position relative to the rod, and there being a second radial spacing between the arms when the forward grip member is in the second position relative to the rod, the second radial spacing being larger than the first radial spacing.

- 4) The handle of claim 3, further comprising:
 - the rod distal end having a connector that attaches the rod to a surgical instrument head.

- 5) The handle of claim 4, further comprising:
the rod connector being adapted for removably attaching the surgical instrument head to the connector.

- 6) The handle of claim 4, further comprising:
the connector having a center bore through the connector; and,
the piston having opposite proximal and distal ends, the piston distal end extending through the connector center bore.

- 7) The handle of claim 6, further comprising:
the rod distal end having a slot adjacent the connector; and
the piston proximal end being positioned in the slot wherein the piston proximal end is adapted to have reciprocating movement of the piston proximal end in the slot and reciprocating movement of the piston distal end in the connector bore.

- 8) A surgical instrument handle comprising:
an elongate rod having a center axis that defines mutually perpendicular axial and radial directions, the rod having a length with axially opposite proximal and distal ends; the rod distal end being adapted to be attached to a surgical instrument head;

a piston mounted on the rod adjacent the rod distal end wherein the piston is adapted for axially reciprocating movement of the piston toward and away from the rod distal end;

a forward grip member operatively connected with the rod wherein the forward grip member is adapted for axial movement between first and second positions of the forward grip member relative to the rod;

a plurality of resilient arms operatively connected with the forward grip member and operatively connected with the piston whereby manual movement of the arms radially inwardly moves the piston axially toward the rod distal end, and movement of the piston axially away from the rod distal end moves the arms radially outwardly, there being a first radial spacing between the arms when the forward grip member is in the first position relative to the rod, and there being a second radial spacing between the arms when the forward grip member is in the second position relative to the rod, the second radial spacing being larger than the first radial spacing; and,

a ring mounted on the rod wherein the ring is adapted to have reciprocating movement of the ring toward the rod proximal end and toward the rod distal end, the ring engaging with the piston.

9) The handle of claim 8, further comprising:

the ring having a sliding surface; and,

the plurality of resilient arms engaging with the ring sliding surface for sliding movement of the arms on the sliding surface when the ring moves toward the rod proximal end and when the ring moves toward the rod distal end, the plurality of resilient

arms moving between the first radial spacing between the arms and the second radial spacing between the arms in response to the sliding movement of the arms on the ring sliding surface.

10) The handle of claim 8, further comprising:

the plurality of arms extending from the forward grip member along the rod, the plurality of arms having distal ends that engage with the ring, the axial movement of the forward grip member relative to the rod moving the distal ends of the arms relative to the rod and the ring.

12) The handle of claim 3, further comprising:

the plurality of arms extending from the forward grip member along the rod, the plurality of arms having distal ends that operatively engage with the piston, the axial movement of the forward grip member relative to the rod moving the distal ends of the arms relative to the rod.

13) The handle of claim 12, further comprising:

the plurality of arms being circumferentially arranged around the rod and the piston.

(9) Evidence Appendix

None.

(10) Related Proceedings Appendix

None.

It is respectfully submitted that the Final Rejection of claims 1, 3-10, 12 and 13 is based on clear errors in the interpretation of the disclosure of the prior art reference relied on in the rejections of the claims, on errors made in interpreting the language of the claims, and on errors in the requirements for anticipation rejections under the patent law.

It is therefore respectfully requested that the Final Rejection of claims 1, 3-10, 12 and 13 be reversed and the claims allowed.

Respectfully submitted,

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